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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/566,533

01/30/2006

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F-8984

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EXAMINER

MCCLELLAND, KIMBERLY KEIL

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

09/08/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/566,533	Applicant(s) MORIURA ET AL.	
	Examiner KIMBERLY K. MCCLELLAND	Art Unit 1791	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 August 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1,2,4,5,15,17 and 19-21.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791

/Kimberly K McClelland/
Examiner, Art Unit 1791

Continuation of 11. does NOT place the application in condition for allowance because: In light of the current amendment, the rejections of claim 22 have been withdrawn.

Applicant's arguments filed 08/23/10 have been fully considered but they are not persuasive.

As to applicant's argument that Lang discloses the method step of shifting the base sheet held on a receiving and transferring roller face, examiner disagrees. Transferring and receiving roller (190) of Lang holds and shifts the base sheet (12) as illustrated in Figures 1, 5, 13, and 14. Instead, applicant asserts roller (184) shifts the base sheet. This argument is not persuasive because roller (184) in Figure 14 clearly contacts and transports the web during operation, serving the function of "holding" and "shifting" the web.

Applicant also argues the method of Lang is not capable of transferring particulate matter in a pattern. This argument is also not persuasive, and Lang clearly discloses transfer of particulate matter (180) onto base sheet (188) in a pattern. See Figure 14.

In response to applicant's argument that the transfer roller brush of Packard transfers particles by releasing them through air or that the method of Packard is "completely different" than the method of Lang, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Packard is relied upon to teach it is known in the art to operate the temporary receiving roller at a slower operational speed. Packard is not relied upon to teach a rotational brush arrangement, as asserted by applicant. Therefore, this argument is not persuasive.

With respect to applicant's assertion that no motivation exists for the proposed combination of Lang with Packard, this argument is not persuasive. Applicant has not addressed the motivation as supplied by the examiner in the action dated 06/21/10. "The motivation would have been to reduce the amount of absorbent particle applied in the absorbent laminate". See paragraph 8. Therefore, this argument is not persuasive.

With respect to applicant's argument that Lang "teaches away" from a combination with Packard, this argument is not persuasive.

Applicant has not provided any instances of Lang which "criticize, discredit, or otherwise discourage the solution claimed...." In *re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

With respect to applicant's argument that there is no reasonable expectation of success for the combination of a slower roller operating speed as disclosed by Packard with the method of Lang, examiner notes applicant has not provided any basis for why such a combination would fail to operate. Simple alteration of transfer roller speed does not further alter the function of the apparatus of Lang, but instead acts to regulate the amount of particle applied to the base sheet. Therefore, examiner's rationale for a reasonable expectation of success arises from the disclosure of Packard that such a minor alteration would be feasible. Consequently, this argument is not persuasive.